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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,775	10/04/2004	Shyam K. Gupta		5774
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SHYAM K. GUPTA BIODERM RESEARCH 5221 E. WINDROSE DRIVE SCOTTSDALE, AZ 85254			EXAMINER WESTERBERG, NISSA M	
			ART UNIT 4173	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,775	Applicant(s) GUPTA, SHYAM K.	
	Examiner Nissa M. Westerberg	Art Unit 1600 4173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 6, 10, 11 and 23 - 39 is/are pending in the application.
- 4a) Of the above claim(s) 6, 11, 26 and 29 - 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 10, 23 - 25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

Applicants' arguments, filed August 29, 2007, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Election/Restrictions

The requirement is still deemed proper and is therefore made FINAL.

Status of Claims

Claims 1, 2, 6, 10, 11 and 23 – 39 are pending. Claims 6, 11, 26 and 29 – 39 are withdrawn as being drawn to non-elected subject matter. Claims 1, 2, 10, 23 – 25, 27 and 28 are currently under examination.

Specification

1. The disclosure is objected to because of the following informalities: Amendments filed August 29, 2007 have introduced new matter to the Application. A non-exhaustive list of new matter is listed below.

Figures 1 – 3 and 5 – 7 introduce new matter. As presented, each horizontal line appears to recite a particular set of substituents for one compound, not a list of all possible values for a particular variable. The possible values for the substituents contain new matter. For example, in figure 1, the $-\text{CH}_2\text{Aryl}$ ring substituent is not supported in the original specification. Another example is when the heterocyclic rings shown in Figure 5 could contain 3 or 4 sulfur atoms. Such ring structures are not supported by the original specification.

[Para 59] of the specification filed August 29, 2007 recites a list of compounds with no stereochemistry. The compounds recited in the analogous section ([para 75]) of the original specification recite those compounds with a (R)-stereochemistry.

[Para107] recites a much longer list of five- and six-membered rings that than present in the analogous section ([Para 113]) of the original specification. Examples of compounds that Examiner can find no basis for in the original specification include acetylpyridine (support for only one particular acetylpyridine, 2-acetylpyridine, is found in the original specification), 8-diazafluoren-9-one and (2E)-1-(1H)-benzimidazol-2-yl)-3-(4-pyridinyl)-2-propen-1-one.

Appropriate correction is required. The examples given above are not an exhaustive list but are intended to point Applicant towards areas where new matter has been added. It is also helpful for the Examiner if Applicant points to where support can

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been added. It is also helpful for the Examiner if Applicant points to where support can be found in the original specification when making amendments.

2. The disclosure is objected to because of the following informalities: abbreviations in the specification are not spelled out with a full name the first time they are used.

Non-exhaustive examples include DADMAC in [Para183], PVM and MA in [Para184] and PABA in [Para186].

Appropriate correction is required.

3. Applicant is respectfully request to submit a substitute specification in accordance with 37 C.F.R. § 1.125(c). 37 C.F.R. § 1.125(c) states that a substitute specification submitted under this section must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

Claim Objections

4. The objection to claim 25 is maintained. Additionally, claims 1, 2, and 10 are objected to because of the following informalities: chemical structures must be in the claims. The claims should stand alone so reference to a figure is not appropriate. Chemical structures must appear in the claims. Appropriate correction is required.

5. Claims 2, 10, 27 and 28 are objected to because of the following informalities: improper Markush language is present. When introducing a list of items that can be selected from, "selected from the group consisting of" to introduce the list with "and" at the end of the list is proper Markush group language. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Two items from the lists in claim 10, resacetophenone and 2,4-dihydroxyacetophenone, are the same chemical compound. It is unclear if Applicant made an error in naming the compounds that has lead to the duplication of items within the list.

Claim Rejections - 35 USC § 102

8. The rejection of claim 1 by Möller et al. (WO 03/03045 A1) is maintained for the reasons of record set forth in the Office Action mailed August 22, 2007.

Claim Rejections - 35 USC § 103

9. The rejection of claim 1, 2, 10, 23 – 25 and 27 – 28 using Möller et al. (WO 03/03045 A1) is maintained for the reasons of record set forth in the Office Action mailed August 22, 2007.

Response to Arguments

10. Applicant's arguments filed August 29, 2007 have been fully considered but they are not persuasive.

Applicant argues that the compositions taught by Möller et al., containing an aromatic or heteroaromatic aldehydes and/or ketones with a second compound will not alter the biological function of a cell and that the possibility exists that the two components could react to form a Schiff base derivative.

The compounds as taught by Möller et al. are present as two separate components. The language of the instant claims to include the word "comprising" is

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open language that indicates other substances can be present. Regardless of whether the two components may react with one another, the individual components including the elected species, are present in a composition as separate components. This can be verified looking at page 43 of the English translation of WO 03/030845, a copy of which is included with this action.

"[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). **MPEP 2112.**

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 2, 10, 23, 25 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 13 and 18 of copending Application No. 10/908,816. Although the conflicting claims are not identical, they are not patentably distinct from each other because these claims recite compositions comprising the same compound, 2,4-dihydroxyacetophenone. The intended use language, a MMP Inhibitor in the instant application and a chaperone to attenuate the accumulation of ubiquitinated proteins in the co-pending application do not make the claims recite patentably distinct subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Claims 1, 2, 10, 23 – 25, 27 and 28 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nissa M. Westerberg whose telephone number is (571) 270-3532. The examiner can normally be reached on M - F, 7:30 a.m. - 5 p.m. ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718 or Cecilia Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

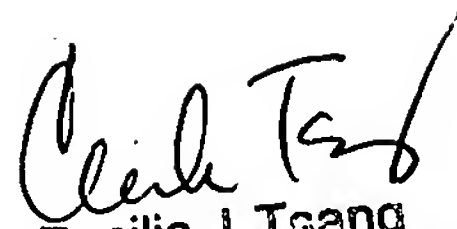
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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